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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,066	09/09/2003	Eric Gascoin	CBL 03235	6106

7590 11/15/2006  
JAMES RAY & ASSOCIATES  
2640 Pitcairn Road  
Monroeville, PA 15146

EXAMINER

LE, HUNG CHARLIE

ART UNIT	PAPER NUMBER
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3663

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/658,066

Applicant(s)

GASCOIN ET AL.

Examiner

Hung C. Le

Art Unit

3663

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 August 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 - 11 is/are pending in the application.
- 4a) Of the above claim(s) 1, 7 - 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2 - 6, & 11 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1 – 11 (Note: Claim 1 was cancelled, Claims 7 – 10 were withdrawn and Claim 11 was added by applicant) have been considered but are moot in view of the new ground(s) of rejection.

### ***Drawings***

2. Figures 1A & 1B should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

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3. Claim 2 is objected to because of the following informalities:

Line 4: " .... said two angle parts..."

Should be: "...said two angled parts..."

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 11:

The term "...are held elastically in a groove..." is unclear. It is not known what is meant and encompasses by the term "held elastically". Therefore, it makes the claim indefinite.

The term "...can be deformed elastically..." is uncertain. It is not known what is meant and encompasses by the term. Therefore, it makes the claim indefinite.

Claim 11 recites the limitation "said clamping tool" in page 6, line 6. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 11, 2 – 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Gasparini (US 6,644,090 B2).

With respect to claim 11: Gasparini (Abstract, Figs. 14 – 20, Claims) discloses:

A system for fixing a bending tool (1), said tool including two parallel fixing surfaces for fixing by clamping and a retaining groove, said system comprising:

- (a) a clamping body (2) having a first clamping surface collaborated with one fixing surface of said tool;
- (b) a tool clamp (4) mounted so that it can pivot, said tool clamp having a second clamping surface, said tool clamp being movable between a first tool-clamping position in which fixing surfaces of said tool are clamped between said first and second clamping surfaces and a second position, in which said second clamping

surface is separated from said first surface of said clamping body allowing mounting/demounting of said tool; and

- © a tool retaining member (6) distinct from said clamping body including a number of mutually parallel elastically deformable blades arranged in a same plane (See Fig. 18), each blade having a first end secured to said clamping body, a running part arranged in such a way that, at rest, it is pressed against said first fixing face of said clamping tool and a second end shifted with respect to said first clamping surface of said clamping body (2), said second end having at least a first angled part angled toward said tool (1) with respect to said running part and a second angled part angled in an opposite direction whereby said angled parts, when said blade is at rest are held elastically in a groove of the tool (1) and whereby, when said clamp (4) is in said second position, said running part of said blade can be deformed elastically (see Fig. 16) to allow said angled parts of said elastically deformable blades to be introduced into or extracted from said groove (See Figs. 16 – 20).

While patent drawings are not drawn to scale, relationships clearly shown in the drawings of a reference patent cannot be disregarded in determining the patentability of claims. See In re Mraz, 59 CCPA 866, 455 F.2d 1069, 173 USPQ 25 (1972).

With respect to claim 2: Gasparini (Abstract, Figs. 14 – 20, Claims) further discloses: wherein when said clamp is in said tool-dismounting second position,

an assembly constituted by said two angle parts are suitable for deforming under effect of pivoting of said tool so that an end of said second angled part becomes disengaged from said retaining groove (See Fig. 14).

With respect to claim 3: Gasparini (Abstract, Figs. 16 – 20, Claims) further discloses: wherein said second angled parts includes a main portion and said end of said second angled part forms an angle with said main portion (See Figs 16 & 18).

With respect to claim 4: Gasparini (Abstract, Figs. 16 – 20, Claims) further discloses: wherein said top edge of said retaining groove is chamfered (See Figs. 16 & 18).

With respect to claim 5: Gasparini (Abstract, Figs. 16 – 20, Claims) further discloses: wherein when said clamp is brought into its clamping position, said retaining member (6) exerts a force having a vertical component on said tool (See Fig. 16).

With respect to claim 6: Gasparini (Abstract, Figs. 16 – 20, Claims) further discloses: wherein said end of said second angled part comes into abutment against the top edge of said retaining groove whatever said position of said clamp (4) (See Fig. 18).

8. The statements of intended use or field of use, e.g., "for fixing, having, at rest, whereby, wherein, for deforming, etc..." clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 512 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

### **Conclusion**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung C. Le whose telephone number is 571-272-



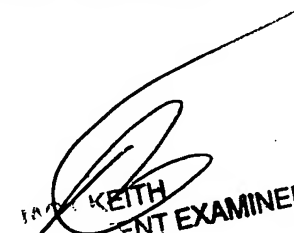
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8757. The examiner can normally be reached on M-F: 07:30am - 05:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack W. Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HCL  
11/10/06

  
JACK W. KEITH  
SUPERVISOR, PATENT EXAMINER